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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,326	07/31/2001	Robert W. Torres	41250/WPC/P526	3726
23363	7590	12/27/2004		
CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068			EXAMINER LUGO, CARLOS	
			ART UNIT 3676	PAPER NUMBER

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/919,326

Applicant(s)

TORRES ET AL.

Examiner

Carlos Lugo

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 5,7-11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5,7-11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is in response to applicant's reconsideration filed on November 29, 2004.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 5,7,8 and 13-15 are rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 3,792,416 to Moulin.

Regarding claims 5 and 8, Moulin discloses a device comprising a sleeve (150) comprising a longitudinal axis and an insertion end and a skirt integrally formed on the sleeve (Figure 2a).

The skirt comprises a first integral section extending in a plane which is substantially perpendicular to the longitudinal axis and a second integral section comprising an interior surface and a sealing surface that extends along the length of the sleeve in a direction opposite to the insertion end such that there is a gap between the interior surface and the sleeve (Figure 2a).

As to the limitation that the skirt is molded, applicant is reminded that the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

As to the limitation that the sealing surface has substantially the same shape of the interior surface of the cavity prior to insertion into the cavity so that the skirt deforms only a small amount to form a seal between the sealing surface and the interior surface of the cavity when the sleeve is subsequently inserted into the cavity is considered as a method step in a device or article claim. The current claim is claiming a device, not a method, therefore, the limitation will not be considered.

As to claims 7, 14 and 15, Moulin discloses that the sleeve includes a wiping land (174).

As to claim 13, Moulin discloses that the skirt is integrally formed in the sleeve (Figure 2a).

4. **Claims 5, 7-11 and 13-16 are rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 5,540,450 to Hayashi et al (Hayashi).

Regarding claims 5 and 8, Hayashi discloses a device comprising a sleeve (3) comprising a longitudinal axis and an insertion end and a skirt integrally formed on the sleeve (14a and 16a, Figure 2).

The skirt comprises a first integral section extending in a plane which is substantially perpendicular to the longitudinal axis and a second integral section comprising an interior surface and a sealing surface that extends along the length of the sleeve in a direction opposite to the insertion end such that there is a gap between the interior surface and the sleeve (Figure 2).

As to the limitation that the skirt is molded, applicant is reminded that the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

As to the limitation that the sealing surface has substantially the same shape of the interior surface of the cavity prior to insertion into the cavity so that the skirt deforms only a small amount to form a seal between the sealing surface and the interior surface of the cavity when the sleeve is subsequently inserted into the cavity is considered as a method step in a device or article claim. Therefore, the limitation will not be considered.

As to claims 7,14 and 15, Hayashi discloses that the sleeve includes a wiping land (6).

As to claims 9 and 16, Hayashi discloses a method of sealing an opening of a cavity comprising the steps:

a) Inserting a portion of a structure (2) through a sleeve (3) of a sealing assembly, wherein the sealing assembly has a molded skirt (14a and 16a, Figure 2) constructed from an electrically insulating, elastomeric material.

b) Inserting a section of the structure including portion of the structure inserted through the sealing assembly into the cavity through the cavity opening so that the molded skirt is in sealing contact with the inside surface of the cavity; wherein the molded skirt comprises a sealing surface that has substantially the same shape as the interior surface of the cavity prior to insertion into the cavity so that the skirt

deforms only a small amount to form a seal between the sealing surface and the interior surface of the cavity (Figure 2).

As to claims 10 and 11, Hayashi discloses the step of cleaning a portion of the interior surface of the cavity using the wiping land (6).

As to claim 13, Hayashi discloses that the skirt is integrally formed in the sleeve (Figure 2a).

### ***Response to Arguments***

5. Applicant's arguments filed on November 29, 2004 have been fully considered but they are not persuasive.

Regarding applicant's arguments that by reciting "molded skirt" it describes a physical characteristic of the sealing surface, i.e. the shape of the sealing surface, which is not dependent on any particular method of achieving the shape (Page 6 Line 23), the term "molded" is considered as a method step.

As to applicant's arguments that the concluding functional phrase "so that the skirt deforms only a small amount to form a seal between the sealing surface and the interior surface of the cavity when the sleeve is subsequently inserted into the cavity" is considered as a method step (Page 7, Line 1), the part that makes the phrase considered as a method step in a device or article claim is "prior to insertion into the cavity". That phrase makes the limitation a method step. Therefore, it would not be considered.

As to applicant's arguments that Hayashi fails to disclose that the sealing surface has substantially the same shape as the interior surface of the cavity prior to

insertion into the cavity (Page 7 Line 27), Hayashi illustrates that the sealing surface has substantially the same shape as the interior surface of the cavity. The term "substantially" is a broad term that does not clearly define the invention.

As to applicant's arguments regarding the rejection to claims 9-11 and 16 (claims directed to a method) in view of Hayashi (Page 8 Line 12), particularly to the fact that Hayashi fails to disclose that the sealing surface has substantially the same shape as the interior surface of the cavity prior to insertion into the cavity, as explained above, the term "substantially" is a broad term that does not clearly define the invention. Therefore, Hayashi illustrates that the sealing surface has substantially the same shape as the interior surface of the cavity.

#### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number is 703-305-9747. The examiner can normally be reached on 9-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

C.L.

Carlos Lugo  
AU 3676

December 15, 2004.



DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
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